

REMARKS

I. Status of Claims

Claims 1-15, 34-38, 47, 48, and 51-94 are currently pending. By this amendment, Applicant has canceled without prejudice claims 16-33, 39-46, 49, and 50. Claims 1, 34-36, and 90 have been amended. Support for the amendment to claims 1 and 90 can be found in the originally-filed specification, for example in paragraph [052] on page 14 and paragraph [053], bridging pages 14-15, as well as original claim 33. Claims 34-36 have been amended to correct an improper dependency created by the present cancellation of claims. No new matter has been added.

II. Rejection under 35 U.S.C. § 112, Second Paragraph

Claim 29 has been rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. According to the Office, the claim lacks sufficient antecedent basis, as the polymers recited therein are non-ionic fatty chain associative polymers. Office Action at 2. Claim 29 has been canceled herein, mooted this basis for rejection. Accordingly, Applicants respectfully request withdrawal of the rejection.

III. Rejection under 35 U.S.C. § 102(b)

Claims 1-4, 16-35, 47-49, 53-73, and 75-94 have been rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent Application Publication No. 2001/0023514 to Cottard et al. ("Cottard"). Applicants respectfully traverse the rejection as it applies to currently pending claims 1-4, 34, 35, 47, 48, 53-73, and 75-94, as amended.

To anticipate a claim, a reference must teach each and every element as set

forth in that claim. M.P.E.P. § 2131. "The elements must be arranged as required by the claim," although identical terminology is not required. *Id.* Furthermore, for a reference to be anticipatory under 35 U.S.C. § 102, it must "clearly and unequivocally disclose the claimed [invention] or direct those skilled in the art to the [invention] without any need for picking, choosing, and combining various disclosures" *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972). Thus, the standard for anticipation requires not only that a reference disclose the elements of the claim, but also that those elements be arranged in the reference as they are arranged in the claim, without picking and choosing from various parts of the disclosure. Cottard simply does not meet this high threshold, and thus does not anticipate the present claims, as amended. Furthermore, Cottard does not render the present claims obvious, as will be discussed below.

Independent claims 1 and 90 are directed towards compositions for the oxidation dyeing of keratin fibers comprising (a) at least one oxidation dye; (b) at least one fatty alcohol; (c) at least one associative polymer chosen from (i) quaternized celluloses modified with groups comprising at least one fatty chain, (ii) quaternized hydroxyethylcelluloses modified groups comprising at least one fatty chain, and (iii) cationic polyurethanes; (d) at least one compound chosen from fatty acid esters and metal oxides; and (in claim 90) (e) at least one oxidizing agent.

While Cottard does admittedly disclose associative polymers such as (i) quaternized celluloses modified with groups comprising at least one fatty chain and (ii) quaternized hydroxyethylcelluloses modified groups comprising at least one fatty chain, that disclosure is included in a laundry list of possible thickening polymers. See Cottard, page 5, paragraphs [0101] and [0102]. Likewise, Cottard does admittedly

disclose representative fatty acid esters, although that disclosure is part of a comprehensive laundry list of hundreds, if not thousands, of potential surfactants. See *id.* at page 16, paragraph [0324]. Moreover, Cottard discloses surfactants as being an optional component to the compositions disclosed therein. *Id.* at paragraph [0317].

It is indisputable that Cottard fails to teach a composition wherein all of the elements are present and arranged as required by the claim. Rather, to arrive at the claimed invention, one skilled in the art would need to pick and choose not only the specifically claimed associative polymers from a seemingly endless list of polymers (see Cottard's disclosure of polymers beginning on page 2 and continuing through page 5), but one skilled in the art would also be required to specifically pick and choose a fatty acid ester from Cottard's **optional** and exhaustive listing of surfactants, spanning three columns of text. See Cottard, pages 16-17.

Moreover, Cottard's only Example fails to disclose a composition as claimed herein, as the example lacks at least one associative polymer chosen from (i) quaternized celluloses modified with groups comprising at least one fatty chain, (ii) quaternized hydroxyethylcelluloses modified groups comprising at least one fatty chain, and (iii) cationic polyurethanes, as claimed herein. Rather, the polymers incorporated into the example include a non-ionic polyether polyurethane, Aculyn 44 (see Cottard at page 5, paragraph [0092]) and a cationic polymer of formula (W), neither of which are within the scope of the present claims, as amended. Accordingly, none of the present claims are anticipated by Cottard.

Furthermore, Cottard does not render the present claims obvious. To establish a *prima facie* case of obviousness, the Office must demonstrate, among other things,

some suggestion or motivation in the reference to combine the reference teachings. M.P.E.P. § 2143. Cottard provides no such motivation. As discussed above, to arrive at the present invention, one skilled in the art would have had to specifically pick and choose the claimed associative polymers and fatty acid esters from laundry list disclosures of ingredients, some of which are reported as being merely optional, and then combine them, absent any suggestion or motivation in Cottard to do so. To the contrary, the only working example fails to incorporate an associative polymer as claimed, and thus to arrive at specifically claimed combination, one would need to sift through a myriad of possible combinations, with no suggestion or guidance from the reference to do so.

The threshold for establishing a motivation to combine is high, requiring "clear and particular" evidence. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617, 175 F.3d 994, 999 (Fed. Cir. 1999). As explained by the Federal Circuit, "[o]ur case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." *Id.*, at 1617, 175 F.3d at 999. Thus, there is no evidence to suggest that one skilled in the art, armed solely with Cottard's disclosure and not the present specification, would somehow arrive at the claimed invention absent improper use of hindsight.

As Cottard fails to anticipate the present claims and fails to meet the high threshold for anticipation set forth by the M.P.E.P., Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102(b). Applicants further point out that no rejection under 35 U.S.C. § 103 would likewise be improper.

IV. Rejections under 35 U.S.C. § 103

A. Cottard

Claim 74 has been rejected under 35 U.S.C. § 103 as allegedly obvious over Cottard. According to the Office, Cottard teaches all of the elements of claim 74, yet the Office admits that “[t]he instant claim[] differ[s] from the reference by reciting fatty alcohol in the percentage amount of 0.5 to 20% as claimed.” Office Action at 5. Nonetheless, the Office concludes the claim would have been obvious “because the reference clearly teaches a composition comprising fatty alcohols in the amounts of 0.05 to 20% . . . , wherein the amount of fatty alcohols in the prior art composition is overlapped with the claimed amounts.” *Id.* Applicants respectfully traverse.

As discussed above, the Office has failed to establish a *prima facie* case of obviousness for at least the reason that there is no suggestion or motivation to modify claim 1, upon which claim 74 indirectly depends. M.P.E.P. § 2143. Accordingly, Applicants respectfully request reconsideration of the rejection.

B. Cottard in view of Eteve

Claims 10-13 have been rejected as allegedly obvious over Cottard in view of U.S. Patent No. 5,788,955 to Eteve et al (“Eteve”). Although the Office recognizes that Cottard “does not teach or disclose the claimed metal oxides,” the Office attempts to rectify that deficiency with Eteve, which teaches “a composition comprising coated titanium oxides as claimed in claim 10-12 . . . and uncoated titanium oxides as claimed in claim 13” Office Action at 6.

Eteve, however, does not cure the deficiencies of Cottard discussed above, and thus no *prima facie* case of obviousness has been established. For at least those reasons, Applicants respectfully request reconsideration of the rejection.

C. Cottard in view of Laurent

Claims 36-46 and 50 have been rejected as allegedly obvious over Cottard in view of U.S. Published Patent Application 2002/0046431 to Laurent et al. ("Laurent"). Although the Office admits that Cottard "does not teach or disclose the cationic amphiphilic polyurethane polymers as claimed," the Office attempts to rectify that deficiency with Laurent as teaching "a composition comprising a cationic polyurethane of formula (Ia)" Office Action at 6-7. Laurent, however, does not cure the deficiencies of Cottard discussed above. Therefore no *prima facie* case of obviousness has been established, and Applicants respectfully request reconsideration of the rejection.

V. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

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Respectfully submitted,

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